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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,202	02/01/2001	Johnny B. Corvin	UV-181	7104

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/775,202	CORVIN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,6-18,35,36 and 40-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6-18,35,36 and 40-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 October 2005 has been entered.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 8, 11, 14-18, 41, 44, and 46-48 of this application as follows:

- The provisional application fails to provide adequate support for "recording a flag with the promotion to indicate the beginning of the program during playback" as recited in claims 8 and 41;
- The provisional application fails to suggest that the "promotion is recorded at any desired point within the program" recited in claims 11 and 44;
- The provisional application fails to provide support for the particular method of distribution of the program, the promotion, and the program guide over either a

"single broadcast channel" or a "plurality of broadcast channels" as recited in claims 14, 15, 46, and 47;

- The provisional application does not disclose details regarding the storage of the program, the promotion, and the program guide data with a "storage unit" or a "plurality of storage units", as recited in claims 16, 17, 18, and 48.

Accordingly, claims 8, 11, 14-18, 41, 44, and 46-48 shall be examined on the basis of the application filling date or 01 February 2001 and claims 1, 6, 7, 9, 10, 12, 13, 35, 36, 40, 42, 43, and 45 are being examined circa the provisional application filling date of 01 February 2000.

Response to Arguments

5. Applicant's arguments filed 05 October 2006 have been fully considered but they are not persuasive.

As noted by applicant (Page 10, Para. 2), O'Connor et al. discloses a recording system that allows for the user to record both programming and promotions and to further enable the playback of recorded material including both the programming and the promotion. The claims, however, are not limiting with respect to what is meant by the commercials being 'independent of the program'. For example, the program and the commercial might be contextually independent (ex. Comedy – Soap Commercial) or independent with respect to the producer (ex. NBC – Proctor & Gamble), or simply independent by some other means. Irrespective of any possible video editing techniques in O'Connor and putting aside that there is no explicit disclosure in O'Connor to preclude any modification to commercials at any

other point in time, so long as the recorded commercial is somehow 'independent' it still reads on the claim. While it is argued that the application provides for the ability to record promotions that are not included in the recorded programming, claims 1 and 35 are completely silent as to this fact.

As previously noted, O'Connor et al. continuously records video programming irrespective of the nature of the programming (with or without commercials). Zigmond et al. explicitly teaches the particular presentation of commercials based upon ad selection criteria [83] that are 'independent of the programming' (Col 11, Lines 31-49). These advertisements may be inserted into the video stream without regard the existence of other advertising (Col 16, Lines 31-43) and may further be recorded for playback with the video program (Col 14, Lines 1-12). Therefore, Zigmond teaches the particular insertion of 'selected' or targeted advertisements that are independent of the video program into the video stream.

Taken in combination, O'Connor et al. teaches the particular display and simultaneous recording of a video stream (and commercials). Zigmond teaches the insertion of 'selected' advertisements into a video stream either on-the-fly or during replay. Therefore, if a viewer of the O'Connor et al. system is watching a video program, the teachings of Zigmond would modify it such to include 'selected advertisement'. These 'selected advertisements' would be recorded (in view of O'Connor et al.) and the user in association with a rewind operation or live viewing would be enabled to view the recorded 'selected advertisement'. Accordingly, the particular combination

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 2, 6-18, 35, 36, and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al. (US Pub No. 2005/0244138 A1) in view of Zigmond et al. (US Pat No. 6,698,020).

In consideration of claim 1, Figure 10 of the O'Connor et al. reference discloses a system for implementing a "method for providing an integrated recorded program/promotion playback asset". The method comprises "recording a selected program for inclusion in the integrated recorded program/promotion playback asset [wherein] the program is selected by a user" as well as "recording a . . . promotion for inclusion in the integrated recorded program/promotion playback asset" (Figures 11-13; Para. [00551], [0059] and [0068] – [0070]). The system subsequently "enables the user to playback the integrated recorded program/promotion playback asset" (Para. [0064]).

O'Connor et al., however, does not necessarily disclose a "selected promotion . . . wherein the selected promotion is independent of the selected program". In an analogous art pertaining to video distribution systems and in particular targeted promotions associated with such, the Zigmond et al. reference discloses "method" for targeted adverting that includes a "selected promotion . . . wherein the selected promotion is independent of the selected program" in accordance with ad selection criteria [83] (Col 6, Lines 3-12; Col 7, Lines 13-61; Col 14, Lines 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify O'Connor et al. with the teachings of Zigmond et al. to "record a selected promotion for inclusion in the integrated recorded/program/promotion playback asset wherein the selected promotion is independent of the selected program" for the purpose of advantageously target, deliver, and present individually targeted advertisements to viewers (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3).

Claim 35 is rejected in light of the aforementioned combined teachings of O'Connor et al. and Zigmond et al.. In particular, Figure 10 illustrates of the O'Connor et al. reference illustrates a "system for providing an integrated recorded program/promotion playback asset". The system comprises a "user input device configured to receive a user input to select a television program to be recorded" [1300] and "user equipment" [1000]. The "user equipment" [1000] is "operative to . . . record the selected program for inclusion in the integrated recorded program/promotion playback asset, [wherein] the program [is] selected by a user" as well as "record[ing] a . . . promotion for inclusion in the integrated recorded program/promotion playback asset" (Figures 11-13; Para. [00551], [0059] and [0068] –

[0070]). The system subsequently "enables the user to playback the integrated recorded program/promotion playback asset" (Para. [0064]).

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Claims 2 and 36 are rejected wherein the "promotion is selected based upon the content of the program" (Zigmond et al.: Col 12, Line 60 – Col 13, Line 6).

Claim 6 is rejected wherein the method further comprises "recording both the program and the promotion on a storage unit" such as the HDD [1018] of O'Connor et al.

In consideration of claims 7, 9-11, 40, and 42-44, the Zigmond et al. reference discloses that "promotions" may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a

program a promotion would be "recorded" at the "beginning of the program", the "end of the program", the "beginning and the end of the program", or "at any desired point within the program" (Zigmond et al.: Col 14, Lines 1-12; Col 16, Lines 20-43). Similarly, the playback of the aforementioned recorded media may have commercials "integrated" at different points in time.

Claims 8 and 41 are rejected wherein the O'Connor et al. reference is operable to "record a flag . . . to indicate the beginning of the program during playback" so as to locate the beginning of a particular program within the storage medium (Figures 3 and 4; Para. [0032] and [0036]).

Claims 12, 13, 16-18, 45, and 48 are rejected wherein the method further comprises "receiving the program and the promotion" and "program guide data" and subsequently "storing" them on a "storage unit" comprising a "plurality of storage units" (Zigmond et al.: Figure 5; Col 12, Line 60 – Col 13, Line 6; Col 14, Lines 1-12; Col 15, Lines 24-34).

Claims 14, 15, 46, and 47 are rejected wherein the "program, the promotion, and the program guide data are received" either via a "single broadcast channel" or via a "plurality of broadcast channels" (Zigmond et al. Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott Beliveau
Primary Examiner
Art Unit 2623

SEB
December 20, 2006